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**IN THE
SUPREME COURT OF THE UNITED STATES.**

OCTOBER TERM, 1941.

EXHIBIT SUPPLY COMPANY,

Petitioner,

vs.

ACE PATENTS CORPORATION

Respondent.

No. **154**

GENCO, INC.,

Petitioner,

vs.

ACE PATENTS CORPORATION

Respondent.

No. **155**

CHICAGO COIN MACHINE COMPANY,

Petitioner,

vs.

ACE PATENTS CORPORATION

Respondent.

No. **156**

PETITION FOR WRITS OF CERTIORARI
To the United States Circuit Court of Appeals
for the Seventh Circuit
and

BRIEF IN SUPPORT.

CLARENCE E. THREEDY,
JOHN H. SUTHERLAND,
Attorneys for Petitioners.

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PETITION FOR WRITS OF CERTIORARI

**To the United States Circuit Court of Appeals
for the Seventh Circuit.**

To the Honorable the Chief Justice of the United States
and the Associate Justices of the Supreme Court of the
United States:

Your petitioners, Exhibit Supply Company, Genco, Inc.,
and Chicago Coin Machine Company, respectfully pray for
writs of certiorari to the Circuit Court of Appeals for the
Seventh Circuit to review the judgments of that court en-
tered on March 12, 1941.

SUMMARY AND SHORT STATEMENT.

Respondent brought separate patent infringement suits against the three petitioners. The cases were consolidated for trial, as well as on appeal.

The patent in suit pertains to a switch for use in ball rolling games or the like.

The application for the patent in suit disclosed, in its specification and drawings, a device including "a coil spring having a leg" (R. 434-5) for electrical contact with "a conductor ring located in the table" (R. 435). As filed, the application suggested no alternative for that structure. All the original claims (R. 437-9) were limited to the spring with the leg.* The application was filed January 12, 1937. On February 27, 1937, one of Petitioners publicly marketed and advertised (Plaintiff's Exhibit 23, R. 357) a device of different† construction from that disclosed in the application (R. 159-160).

Thereafter, in June, 1937, the application was broadened by the amendatory insertion of a claim (R. 445) calculated to cover the intervening device. The solicitor confessed (R. 450-51) that other claims would be "avoided by taking the leg 19, separating it from the spring 18, and embedding it as a pin in the table," and admitted that the new claim was intended to cover such alternative structure. The Patent Office rejected the claim, holding as to the suggested alternative (R. 452) "no such structure has been brought out by the drawings or specification." That holding was

*Claim 1: "a spring including an extension."

Claim 2: "a pendant coil spring including an extension."

Claim 3: "a coil spring having a leg."

Claim 4: "a coil spring having a leg."

Claim 5: "a coil spring having a leg."

Claim 6: "a pendant coil spring having a depending leg."

†This (Plaintiff's Exhibit 5) is now charged to infringe. It differs from the device disclosed in the patent in suit essentially in that the spring has no leg, and the table has no ring, but has a nail for engagement with the spring.

acquiesced in—the claim further amended (R. 453) and allowed, as Claim 4 of the patent.

That claim, as originally presented, was broad in defining the relationship between the conductor and the table as “carried by the table”; but, pursuant to rejection, the claim was amended to limit that relationship to one in which the conductor was “embedded in the table” (R. 450).

Such is the history of the single claim in suit.

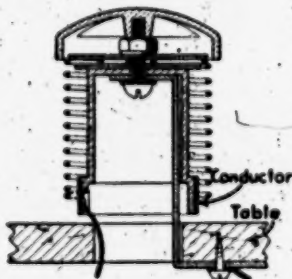
Decisions of the Courts Below.

The District Court held (R. 485) the patent valid and infringed, not only by the above-mentioned intervening device, but also by other and more remote devices, none of which had the originally claimed spring with a leg.† Thus the District Court accorded the patent in suit a wide range of equivalents, notwithstanding that the Court recognized the patent to be of no “great significance” (R. 487) in the art, and notwithstanding that by so holding the District Court in effect enlarged the claim back to its preamended scope.

The District Court refused in its decision (R. 485-86) to sustain the file wrapper estoppel defense, but made neither finding of fact nor conclusion of law anent it.

The Circuit Court of Appeals affirmed the District Court and reasoned that since the patentee had forecast (in the

†And as to whether the conductor is embedded in the table, we let the found-infringing structures speak for themselves. For example, Plaintiff's Exhibit 9 (R. 21) is here reproduced.



informal "Remarks" of an amendment filed after the appearance of Petitioners' intervening device) the alternative structure which Petitioners first adopted, the amendment (from "carried by the table" to "embedded in the table") did not limit the range of mechanical equivalents so as to exclude any fixed and unyielding relationship between the table and the conductor.

Thus the Court of Appeals has ruled that the doctrine of mechanical equivalents avails to enlarge the scope of a patent monopoly beyond the verbal bounds of the claim, notwithstanding that:

(a) To secure the allowance of the claim the patentee was compelled to restrict it in the very aspect which the Court of Appeals enlarges.

(b) The application was broadened after adverse rights of the public (derived through petitioners) had intervened.

QUESTIONS PRESENTED.

1. Is the scope of a patent limited by its claims or may it be enlarged therebeyond by the so-called doctrine of mechanical equivalents?

2. Does an informal remark (in one of the applicant's communications with the Patent Office) about an alternative structure, not originally suggested or claimed, render inapplicable the rule that, a claim which was rejected and surrendered during the pendency of an application cannot be revived and restored to a patent, either by construction or by applying the doctrine of mechanical equivalents of an allowed claim?

3. When, during the pendency of an application, the applicant presents a claim calculated to cover an alternative structure not disclosed in the original application, the Patent Office rules that the alternative structure is not

brought out by the specification or drawing, the ruling is acquiesced in, the claim amended to conform it to the specification, and as thus amended, allowed—is the patentee estopped to contend that the amended and allowed claim covers the alternative structure sought to be covered by the rejected and surrendered claim?

REASONS RELIED UPON FOR ALLOWANCE OF THE WRITS.

It is believed that the writs should be granted in these cases for the following reasons:

I.

The law with respect to mechanical equivalents is in a confused state. The doctrine that the scope of a patent monopoly may be enlarged beyond the verbal scope of the claims is an anomaly. It violates (Claude Neon Lights v. E. Machlett & Son, 36 F. 2d 574, C. C. A. 2) the underlying and necessary principle that the disclosure is open to the public, save as the claim forbids; and that it is the claim, and that alone, which measures the monopoly.

That doctrine had its inception in *Winans v. Denmead*, 56 U. S. 330. That was a five to four decision. Justice Campbell wrote a vigorous dissent, in which he (as experience has shown) correctly forecast "nothing . . . will be more mischievous, more productive of oppressive and costly litigation, of exorbitant and unjust pretensions and vexatious demands, more injurious to labor."

While this Court has not applied the doctrine of mechanical equivalents to enlarge the scope of a patent claim since 1892 (*Hoyt v. Horne*, 145 U. S. 302), its subsequent decisions* have never overruled *Winans v. Denmead*. Con-

*In *Hildreth v. Mastoras*, 257 U. S. 27; *Continental Paper Bag Co. v. Eastern Paper Bag Co.*, 210 U. S. 405, and *Sanitary Refrigerator Co. v. Winters*, 280 U. S. 30, this Court discussed the doctrine of equivalents, but refused to limit claims to less than their apparent verbal scope.

sequently, the lower courts have proceeded, and may be expected to continue, to enlarge the scope of patents beyond the plain verbiage of the claim upon the pretext of "mechanical equivalents," unless this court intercedes.

That the doctrine has been troublesome to the Courts is well illustrated by Judge Learned Hand's exposé of its anomalous and inconsistent character in *Claude Neon Lights v. Machlett*, *infra*, Brief pages 13-14. It has not only been perplexing to the Courts, but vexatious to industry, and, not infrequently, a source of false hope to inventors. It is safe to say that patent litigation would be markedly reduced if the doctrine of mechanical equivalents were either clarified or abolished.

It is of special importance at this time that this Court should seize an opportunity to take this uncertainty out of patent interpretation, so that the manufacturing public may know whether, when a thing is outside the language of a claim, it is or is not an infringement of the patent.

II.

The decision of the Circuit Court of Appeals subverts the basis of this Court's pronouncements with regard to amendments, and perverts what is normally an onus upon the patentee, into a benefit to him.

It is settled that after adverse rights of the public have intervened a patent applicant may not revise his description and broaden his claim to embrace the intervening device (*Schriber-Schroth v. Cleveland Trust*, 305 U. S. 47, and cases cited page 57). In fact, the court below has held a broadened claim to be invalid under such circumstances (*Automatic Devices Co. v. Sinko*, 112 F. [2d] 335).

The decision in the instant case, however, condones the same result, when, instead of formally amending the description to embrace such an alternative, the patentee informally mentions the alternative in the "Remarks" of

an amendment. Normally, an amendment adding a broadened claim would be regarded "with jealousy and disfavor" (*Railway Company v. Sayles*, 97 U. S. 554). Normally a limiting amendment to a claim (like from "carried by" to "enbedded in") would be "strictly construed against the inventor, and in favor of the public" (*Shepard v. Carrigan*, 116 U. S. 598). But the Circuit Court of Appeals has here held that the informal mention of petitioners' device (undisclosed and unclaimed in the original application) in one of the communications to the Patent Office not only brings that device within the patent, but renders an otherwise limiting amendment unimportant. Thus the Court has not only permitted the patentee to do informally what he could not do formally, but has used the informal suggestion to enlarge the range of equivalents as if it had been a part of the original application.

This is a new interpretation. If it is right, this Court should approve it, so that patent applicants may, with confidence, adopt the practice and gain the advantage. If, as we think, it is wrong, this Court should hasten to overrule the practice, before it becomes widespread. It is of paramount importance to every member of the patent dealing public that this Court approve or disapprove such a radical departure from what we think is the basis of the established law.

PRAYER.

Wherefore, your Petitioners respectfully pray that writs of certiorari be issued to the United States Circuit Court of Appeals for the Seventh Circuit to the end that these causes may be reviewed and determined by this Court; that the decrees of the Circuit Court of Appeals for the Seventh Circuit be reversed, and that petitioners be granted such other and further relief as may be proper.

**EXHIBIT SUPPLY COMPANY,
GENCO, INC.,
CHICAGO COIN MACHINE COMPANY,**

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ACE PATENTS CORPORATION	Respondent.	

**BRIEF IN SUPPORT OF PETITION FOR
WRITS OF CERTIORARI.**

OPINIONS OF COURTS BELOW.

The opinion of the District Court is found at R. 485. It is reported at 45 U. S. Patent Quarterly* 601.

The District Court's Findings of Fact and Conclusions of Law in the three cases extend from R. 488 to R. 515, but are substantial duplicates of each other in the respective cases.

The opinion of the Circuit Court of Appeals is reported

at 48 U. S. Patent Quarterly* 667, and appears at pages 670 to 679 of the Record.

JURISDICTION.

The judgment of the Circuit Court of Appeals was entered March 12, 1941.

The statute giving jurisdiction is Section 240-A of the Judicial Code (28 U. S. Code, Sec. 347); *Schriber-Schroth v. Cleveland Trust Co. et al.*, 305 U. S. 47.

STATEMENT OF THE CASE.

The foregoing Petition contains a summary of the material facts necessary to an understanding of the reasons relied upon for the allowance of the writ, as well as a statement of questions involved in the case.

SPECIFICATION OF ERRORS.

1. That the Circuit Court of Appeals erred in allowing an informal remark about Petitioners' structure (not originally described or claimed) to deprive a limiting amendment of its effect as a file wrapper estoppel.

2. That the Circuit Court of Appeals erred in applying the doctrine of mechanical equivalents to enlarge the monopoly of the patent in suit beyond anything described or claimed in the original application.

3. That the Circuit Court of Appeals erred in failing to hold that Respondent was estopped by the file wrapper history from contending that Petitioner's device (which was informally mentioned to the Patent Office and ruled out) is within the scope of the claim in suit.

4. That the Circuit Court of Appeals erred in affirming and in not reversing the judgment of the District Court.

*It has not yet appeared in the Federal Reporter Series.

ARGUMENT.

I.

The Doctrine of Mechanical Equivalents Is Incompatible With the Doctrine That the Patent Claim Measures the Invention; and Enlargement of a Patent Monopoly to Embrace Mechanical Equivalents, Not Within the Plain Terms of the Claim, Is a Relaxation of the Statutory Requirements.

No statute defines infringement. Section 4888 of the Revised Statutes (35 United States Code 33) does require that a patentee "shall particularly point out and distinctly claim the part, improvement or combination which he claims as his invention."

The purpose has been stated by this Court as:

" 'to inform the public during the life of the patent of the limits of the monopoly asserted, so that it may be known which features may be safely used or manufactured without a license and which may not.' *Permutit Co. v. Graver Corporation*, 284 U. S. 52, 60. It follows that the patent monopoly does not extend beyond the invention described and explained as the statute requires. *Permutit Co. v. Graver Corporation*, *supra*, at 57. That it cannot be enlarged by claims in the patent not supported by the description. *Snow v. Lake Shore & M. S. Ry. Co.*, 121 U. S. 617; cf. *Smith v. Snow*, 294 U. S. 1" (*Schriber-Schroth Co. v. Cleveland Trust Co. et al.*, 305 U. S. 47, *l. c.* 57).

Thus it would seem that nothing is an infringement of a patent which is not embraced by its claim.

But there is another line of cases, beginning with *Winans v. Denmead*, 56 U. S. 330, which hold that a mechanical equivalent of the thing disclosed in a patent is an infringement, even though it is not embraced by the language of

the claim. That this is wholly inconsistent with the principle that the invention must be claimed, and that it constituted a relaxation of the requirements of the statute, was recognized at the outset. In the dissenting opinion of Mr. Justice Campbell (concurring in by Mr. Chief Justice Taney, Mr. Justice Catron, and Mr. Justice Daniel) in *Winans v. Denmead*, this was pointed out as follows:

“The patentee, not exaggerating the theoretical superiority of the form of his car, overlooked those facts which reduced its practical value to the level of cars of a form widely variant from his own. The object of this suit is to repair that defect of observation. It is, that this court shall extend, by construction, the scope of operation of his patent, to embrace every form which in practice will yield a result substantially equal or approximate to his own.” L. c. 346.

“• • • The patentee is obliged, by law, to describe his invention, in such full, clear and exact terms, that from the description, the invention may be constructed and used. Its principle and modes of operation must be explained; and the inventor shall particularly ‘specify and point’ out what he claims as his invention. Fulness, clearness, exactness, preciseness and particularity, in the description of the invention, its principle, and of the matter claimed to be invented, will alone fulfill the demands of Congress or the wants of the country. Nothing, in the administration of this law, will be more mischievous, more productive of oppressive and costly litigation, of exorbitant and unjust pretensions and vexatious demands, more injurious to labor, than a relaxation of these wise and salutary requisitions of the act of Congress. In my judgment, the principles of legal interpretation, as well as the public interest, require that this language of this statute shall have its full significance and import.”

That there is conflict between the doctrine of equivalents and the doctrine that a patent is limited by its claims has

been recognized by some of the Courts: *Otis Elevator Co. v. Atlantic Elevator Co., Inc.*, 47 F. (2nd) 545 (C. C. A. 2); *Oates v. Camp*, 83 F. (2nd) 111 (C. C. A. 4), and *Directorate Corp. v. Donaldson Lithographing Co.*, 51 F. (2nd) 199, 1. c. 202 (C. C. A. 6). Judge Learned Hand fully exposed this fundamental conflict in his decision in *Claude Neon Lights v. E. Machlett & Son et al.*, 36 F. (2nd) 574. The length of the quotation is acquitted by its clarity and appositeness:

“ . . . The doctrine of equivalents, though well settled for many years, is anomalous, if the claim is measured only by its words, and for this reason we once went so far as to say that it means no more than that the language of claims shall be generously construed. *Motion Pictures Co. v. Independent Co.*, 200 F. 411 (C. C. A. 2). Such a limitation is, however, irreconcilable with those extremely numerous decisions which have extended a claim to structures which by no possibility it could cover, judged by any tenable canons of documentary interpretation. *Winans v. Denmead*, 15 How. 330, 343, 14 L. Ed. 717; *Blake v. Robertson*, 94 U. S. 728, 24 L. Ed. 245; *Clough v. Gilbert & B. Mfg. Co.*, 106 U. S. 166, 1 S. Ct. 188, 27 L. Ed. 134; *Royer v. Schultz Belting Co.*, 135 U. S. 319, 10 S. Ct. 833, 34 L. Ed. 214; *Hoyt v. Horne*, 145 U. S. 302, 12 S. Ct. 922, 36 L. Ed. 713; *Reece Button-Hole Mach. Co. v. Globe Button-Hole Mach. Co.*, 61 F. 958 (C. C. A. 1); *McCormick Harvesting Mach. Co. v. C. Aultman & Co.*, 69 F. 371 (C. C. A. 6); *McSherry Mfg. Co. v. Dowagiac Mfg. Co.*, 101 F. 716 (C. C. A. 6). ”

“ It is plain that such latitude violates in theory the underlying and necessary principle that the disclosure is open to the public save as the claim forbids, and that it is the claim and that alone which measures the monopoly. *Keystone Bridge Co. v. Phoenix Iron Co.*, 95 U. S. 274, 278, 24 L. Ed. 344; *Yale Lock Co. v. Greenleaf*, 117 U. S. 554, 559, 6 S. Ct. 846, 29 L. Ed.

952; *White v. Dunbar*, 119 U. S. 47, 52, 7 S. Ct. 72, 30 L. Ed. 303; *McClain v. Ortmyer*, 141 U. S. 419, 424, 12 S. Ct. 76, 35 L. Ed. 800; *Minerals Separation v. Butte etc. Co.*, 250 U. S. 336, 350, 39 S. Ct. 496, 63 L. Ed. 1019. The vacillation in the decisions is a necessary consequence of this inconsistency in theory, somewhat analogous to the similar inconsistency which pervades reissues and amendments. It is the claim which singles out from the complex disclosed those elements which constitute the 'invention,' and substantially the whole work of the Patent Office lies in determining, not whether the disclosure is new because all of it never is, but whether the claims proposed are. Strictly the disclosure should be used therefore only as the setting of the claims and to find what the words employed really mean. Otherwise courts would have to assume the duties of the office afresh and compose such claims as the prior art might have allowed, had the patentee been foresighted enough to include all possible variants of his meaning. Such a result the decisions have repeatedly repudiated, and it would result in an intolerable burden upon the public, which would be charged not only with a knowledge of the prior art at the time of the application and often earlier, but with a right conclusion as to how much room was left for invention, seldom an easy question."

He concluded that the doctrine of equivalents is applied "in misericordiam to relieve those who have failed to express their complete meaning."

More recently, in *Keith v. Charles E. Hires & Co., Inc.*, 116 F. (2) 46, Judge Learned Hand has again pointed out:

"* * * While it is sometimes said that every claim has some range of equivalents, it is as often said that one may not wholly disregard any element of a claim. Without seeking to reconcile that conflict * * *"

The pronouncements in this Court's recent decisions

(Schriber-Schroth v. Cleveland Trust Co. et al., 305 U. S. 47; Schriber-Schroth v. Cleveland Trust Co. et al., 311 O. S. 211; General Electric v. Wabash, 304 U. S. 364, and Permutit v. Graver Corp., 284 U. S. 52) seem to require strict compliance of the statutory requirements. If that be so, the doctrine of mechanical equivalents is passé, at least in so far as it has been and still is being used to enlarge the monopoly of a patent beyond the plain language of its claim. Otherwise, the claim is a vain thing, and the statute requiring it is impotent.

II.

The Doctrine of File Wrapper Estoppel Cannot be Negatived and a Patent Converted From Narrow to Broad by an Informal Remark Made in a Communication to the Patent Office, When the Substance of the Remark, If Made as a Formal Amendment to the Specification, Would Have Destroyed the Patent.

The claim in suit here is limited (verbally, at least) to devices wherein the conductor is actually embedded in the table. This is because the claim originally called for a conductor merely "carried by" the table, and in compliance with the requirement of the Patent Office was limited to an arrangement in which the conductor was "embedded in the table."

But the Court of Appeals reasoned, in this case, that because the applicant "forecast" an alternative structure (not originally described or claimed in the application) the teeth are not only taken out of the estoppel, but the word "embedded" comes to mean anything which has a fixed and unyielding relation.

The "forecast" to which the Circuit Court of Appeals refers was the reference (in one of the communications with the Patent Office) (R. 450.1) to a structure such as

Petitioners were then marketing (and is here held to infringe). It was not as formal amendment to the application, but was an informal "remark." Had this been done as a formal amendment Respondent would have been clearly within the rule that an

"application for patent cannot be broadened by amendment so as to embrace an invention not described in the application as filed, at least when adverse rights of the public have intervened" (Schriber-Schroth v. Cleveland Trust Co., 305 U. S. 47, and cases cited page 57).

To have so formally amended the specification would have brought the case within the rule of Powers Kennedy Contracting Co. et al. v. Concrete Mixing and Conveying Co.* (282 U. S. 175), where this Court said:

"This of itself destroys the patent."

Unless there is some magic in doing informally what could not be done formally, the ruling of the Court of Appeals violates several well-settled rules:

(a) That a rejected-amended-allowed claim cannot be restored to its preamended scope by construction (Schriber-Schroth v. Cleveland Trust Co. et al., 61 Sup. Ct. 235, 311 U. S. 211).

(b) That a rejected-amended-allowed claim cannot be restored to its preamended scope by resort to the doctrine of equivalents (Smith v. Magic City Kennel Club, 282 U. S. 784).

(c) That an amendment after rejection is to be strictly construed against the inventor, and in favor of the public; and looked upon as in the nature of a disclaimer (Smith v. Magic City Kennel Club, 282 U. S. 784; Shepherd v. Carrigan, 116 U. S. 593, 598,

*Under such circumstances the broadened claim was held invalid in Automatic Devices Co. v. Sinko, 112 F. (2d) 335.

and *Sargent v. Hall Safe and Lock Company*, 114 U. S. 63).

(d) That where an original application shows but one form, and discloses no alternatives, the patent is to be restricted to that form (*Snow v. Lake Shore & M. S. Ry. Co.*, 121 U. S. 617, 630, cited with approval, *Schriber-Schroth v. Cleveland Trust*, 305 U. S. 47; l. c. 57).

(e) That a patent which is not of "great significance" (R. 487) in the art must be strictly construed, and limited to a narrow range of equivalents (*Miller v. Eagle Manufacturing Co.*, 151 U. S. 186; *Continental Paper Bag Co. v. Eastern Paper Bag Co.*, 210 U. S. 405).

(f) That when the terms of the claim are clear and distinct, the patentee is bound by the plain meaning of the same (*Continental Paper Bag Co. v. Eastern Paper Bag Co.*, 210 U. S. 405; *Keystone Bridge Company v. Phoenix Iron Company*, 95 U. S. 274).

The claim in suit was injected into the application for the stated purpose of attempting to cover devices of a type here accused. Considering the claim on the basis of the purpose stated by the Applicant, as well as in the light of the disclosure of the application, the Patent Office rejected it, pointing out:

"Claim 7 . . . rejected as describing an inoperative structure in view of the applicant's disclosure. . . . It is true as the applicant suggested that if the portion 19 were removed from the spring and embedded in the table an operative device would result but no such structure has been brought out by the drawing or specification" (R. 452).

Without traverse, the claim was then amended to conform it to the device originally disclosed. Manifestly, the Patent Office considered this surrender as the equivalent of

a disclaimer; but the effect of the decision of the Court below is to allow the patentee to retract that disclaimer.

The rejected-amended-allowed claim here in suit was not only broader, when presented, than any claim in the case as filed, but remained broader after the amendment. Hence the claim remains subject to the rule that it must be regarded "with jealousy and disfavor" (*Railway Company v. Sayles*, 97 U. S. 554), which is the very antithesis of what the Court below has done. Any one of several rules of law would have operated to restrict this patent in suit had the patentee not made his informal "forecast." Had the "forecast" been made by formal amendment to the specification, the patent would have been destroyed. No canon of law or logic will sustain the proposition that when formality will destroy, informality will not only save, but improve.

CONCLUSIONS.

From the foregoing, we submit, it appears that the decision of the Circuit Court of Appeals for the Seventh Circuit is inconsistent with the policy of the patent laws in respects which are important, not only to these petitioners, but to the public, inventors and industry at large.

Wherefore your petitioners pray that their petition be granted, that the Writs of Certiorari be issued, and the causes reviewed, and the decrees of the Court of Appeals reversed.

Respectfully submitted,

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June 9, 1941.

